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A 2665
Docket No.: 65948/P062US/10400203
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Piu B. Wong et al.

Application No.: 09/874,932

Confirmation No.: 3483

Filed: June 5, 2001

Art Unit: 2665

For: DIRECTED MAXIMUM RATIO COMBINING
METHODS AND SYSTEMS FOR HIGH DATA
RATE TRAFFIC

Examiner: P. B. Nguyen

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed December 15, 2004, Applicant hereby provisionally elects claims 1-13 for examination. The election is being made WITH TRAVERSE. Applicant respectfully requests reconsideration and withdrawal of the restriction requirement in light of the arguments set forth below.

The Examiner has required restriction between:

Group I - Claims 1-13

Group II - Claims 14-20

Group III - Claims 21-23

Group IV - Claims 24-40

The Office Action indicates Groups I, II, III and IV are related as combination and subcombination. In addressing the criteria of distinctness for combinations and subcombinations M.P.E.P. §806.05(c) provides:

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP §808.02.

The Office Action states: "these inventions...have acquired a separate status in the art as shown by their different classification." Applicant wishes to respectfully point out that the Office Action indicates that each of the groups of claims are classified in U.S. Patent Class 370. The Office Action does not provide any evidence that the alleged Groups have different fields of search and applicants respectfully allege that the pending claims have a common field of search. Therefore, Applicant respectfully contends that search and examination of the entire application can be made without serious burden on the Examiner. In such a circumstance MPEP §803 requires that the Examiner must examine the application on the merits, even though it includes claims to independent or distinct inventions. Therefore Applicant respectfully contends that all of the pending claims in this application, claims 1-40, should be examined on the merits.

M.P.E.P. §806.05(c) also provides:

The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct.

In addressing the claims of Group I, the Office Action states that:

the combination as claimed does not require the particulars of the subcombination as claimed because the invention I is drawing to a method of transmitting data from a plurality of a mobile stations to a base stations, the method comprising transmitting data from the first set of mobile stations at a higher time average data rate than data transmitted from the second set of mobile stations.

In addressing the claims of Group II, the Office Action states that:

The subcombination has separate utility such as the invention II is drawing to a method of transmitting data from a plurality of mobile stations to a base station, the method comprising transmitting data from the selected mobile stations simultaneously during a next time slot;

As admitted by the Office Action the claims of each of Group I and Group II are directed to a method for transmitting data from a plurality of mobile stations to a base station. Thus, Applicant respectfully asserts that the Office Action has failed to show how the alleged subcombination of group II has separate utility from the alleged combination of Group I. Therefore, Applicant respectfully urges that at least the claims of Group II, claims 14-20, should be examined with the provisionally elected claims of Group I, claims 1-13.

Conclusion

For at least the forgoing reasons Applicant respectfully contends that restriction is improper in this case. Therefore Applicant respectfully requests withdrawal of the pending restriction requirement.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 06-2380, under Order No. 65948/P062US/10400203 from which the undersigned is authorized to draw. If the below named attorney can be of assistance in expediting prosecution of the present application, the Examiner is respectfully encouraged to call the attorney at the number indicated below.

Dated: January 18, 2005

Respectfully submitted,

By 

Jerry L. Mahurin

Registration No.: 34,661

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Application No. : 09/874,932

Attorney Docket No.: 65948/P062US/10400203

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AMENDMENT TRANSMITTAL LETTER

Docket No. ☐ 65948/P062US/10400203

Application No.
09/874,932-Conf. #3483

Filing Date
June 5, 2001

Examiner
P. B. Nguyen

Art Unit
2665

Applicant(s): Piu B. Wong et al.

Invention: DIRECTED MAXIMUM RATIO COMBINING METHODS AND SYSTEMS FOR HIGH DATA RATE TRAFFIC

TO THE COMMISSIONER FOR PATENTS

Transmitted herewith is an amendment in the above-identified application.

The fee has been calculated and is transmitted as shown below.

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CLAIMS AS AMENDED

	Claims Remaining After Amendment	Highest Number Previously Paid	Number Extra Claims Present	Rate	
Total Claims	40	- 40 =		x	
Independent Claims	6	- 6 =		x	
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					
Other fee (please specify):					
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT:					0.00

☒ Large Entity

☐ Small Entity

☒ No additional fee is required for this amendment.

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A duplicate copy of this sheet is enclosed.


☐ A check in the amount of \$ _____ to cover the filing fee is enclosed.

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☒ The Director is hereby authorized to charge and credit Deposit Account No. 06-2380
as described below. A duplicate copy of this sheet is enclosed.

☒ Credit any overpayment.

☒ Charge any additional filing or application processing fees required under 37 CFR 1.16 and 1.17.


Jerry L. Mahurin

Attorney Reg. No.: 34,661

Dated: January 18, 2005

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